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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,867	03/26/2004	Masanori Ueda	025720-00027	7607
7590	02/13/2006		EXAMINER	
AREN'T FOX KINTNER PLOTKIN & KAHN, PLLC Suite 400 1050 Connecticut Avenue, N.W. Washington, DC 20036-5339			TUGBANG, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/809,867	UEDA ET AL.	
	Examiner	Art Unit	
	A. Dexter Tugbang	3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS,  
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 31 October 2005.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-17 are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

<ol style="list-style-type: none"> <li>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.</li> </ol>	<ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</li> <li>6)<input type="checkbox"/> Other: _____.</li> </ol>
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**DETAILED ACTION**

***Election/Restrictions***

1. Upon further consideration, the previous restriction requirement (dated October 31, 2005) has been withdrawn in view of the following. Any delay in prosecution is deeply regretted.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13, drawn to a process of making a surface acoustic wave device, classified in class 29, subclass 25.35.
  - II. Claims 14-17, drawn to a product of a surface acoustic wave device, classified in class 310, subclass 313R.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions of Groups I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of Group II can be made by a materially different process, such as one that forms surfaces of the piezoelectric substrate by strictly coating or molding with no grinding or polishing, as required by Group I.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. If applicant(s) elect the invention of Group I, then a further restriction to one of the inventions of Group I is required under 35 U.S.C. 121:

- I-A. Claims 2-4, drawn to a process of making a surface acoustic wave device including cutting a joined piezoelectric substrate into parts each having patterns arranged two-dimensionally, classified in class 29, subclass 417.
- I-B. Claims 5, 6 and 9, drawn to a process of making a surface acoustic wave device including joining the piezoelectric substrate to a first substrate having a single cavity in which the on-chip pattern is housed, classified in class 29, subclass 841.
- I-C. Claims 7 and 8, drawn to a process of making a surface acoustic wave device including joining the piezoelectric substrate to a first substrate with multiple cavities and subsequently cutting the piezoelectric substrate, classified in class 29, subclass 852.
- I-D. Claim 10, drawn to a process of making a surface acoustic wave device including subjecting the piezoelectric substrate to a surface activation process, classified in class 29, subclass 830.

The inventions are distinct, each from the other because of the following reasons:

6. Inventions of Groups I-A through I-D are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable, or each having separately usable manufacturing processes.

In the instant case, the invention of Group I-A has separate utility, or a separately usable process, of cutting a joined piezoelectric substrate into parts each having patterns arranged two-dimensionally, not required in any of Groups I-B through I-D.

Group I-B has separate utility, or a separately usable process, of joining the piezoelectric substrate to a first substrate having a single cavity in which the on-chip pattern is housed, not required in any of Groups I-A or I-C through I-D.

Group I-C has separate utility, or a separately usable process, of joining the piezoelectric substrate to a first substrate with multiple cavities and subsequently cutting the piezoelectric substrate, not required in any of Groups I-A, I-B or I-D.

Group I-D has separate utility, or a separately usable process, of subjecting the piezoelectric substrate to a surface activation process, not required in any of Groups I-A through I-C.

See MPEP § 806.05(d).

7. Because these inventions are distinct for the reasons given above and the search required for example, in Group I-A is not required for in Groups I-B through I-C, restriction for examination purposes as indicated is proper.

8. Claim 1 link(s) the inventions of Groups I-A through I-D. The restriction requirement between the linked inventions in Group I is subject to the nonallowance of the linking claim(s), Claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant

application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

NOTE: Claims 11-13 will be examined with linking Claim 1 as there would be no burdensome search to examine Claims 11-13.

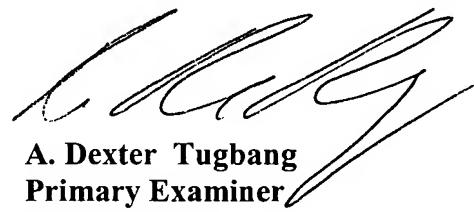
9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 571-272-4570. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A. Dexter Tugbang  
Primary Examiner  
Art Unit 3729

February 9, 2006